

REMARKS

In order to specifically indicate the features of the referenced application, the features in the original claim 2 are incorporated into claim 1. Claim 4 is amended to add in the word "pulses" so as to show that the method of the referenced application is provided with a step of applying two or a set of stimuli.

Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevenson, et al. (US Patent 881,087; '087 hereinafter). The Examiner stated that the '087 patent discloses a method of generating a stimulation signal to a non-invasively stimulating the stimulation points surrounding K1 and FHA acupuncture points with at least a set of non-invasive electrical stimulation. Then the Examiner continues to indicate that although the '087 patent does not explicitly state placement over the K1 and FHA acupuncture points, it is clear from Fig. 2 of the '087 patent that the '087 patent delivers electrical stimulation to the claimed foot region and, therefore, the claimed invention does not distinguish over the prior art.

The fact Unsworth ('080) was granted a US patent in light of the prior art Stevenson ('087) confirms that it is well known in the art that narrowing down the application scope of an art to best deliver the outcome is novel over the prior art.

It is the Applicant's view that Unsworth ('080) was allowed because it applies electrical stimulation on the sole instead of on or close to the calf where the symptom resides, which makes it novel and non-obvious to others practicing in the art.

Likewise, the present application proposes stimulating two very specific acupuncture points, K1 and FHA, concurrently using the same signal. This has not been disclosed by any prior art nor is it obvious from the two closest arts – Stevenson ('087) and Unsworth ('080). Unsworth ('080) also teaches stimulating the ball and heel region of the insole under the principle of NMES only, to treat their claimed disease. The present application is a combination

of local NMES and remote electrical nerve stimulation through acupuncture points around K1 and FHA, to effect the moderation of back pain. Therefore, even though Unsworth ('080) did teach stimulating the ball and heel of the insole, similar to stimulating K1 and FHA areas of the referenced application, it is however not obvious to those practicing in the art that by focusing on stimulating concurrently specific acupuncture points surrounding K1 and FHA, the effect of moderating back pain can be achieved.

Further, the Examiner continues to indicate that it is possible to non-invasively and concurrently stimulate the group of stimulation points surrounding K1 and FHA acupuncture points by manually applying pressure and rubbing each of these areas on the soles of the feet with a thumb or finger in order to moderate lower and upper back pain.

The problem solving technique used in the present application is not about applying stimulation on ANY acupuncture points, but only on acupuncture points surrounding K1 and FHA. This concept is crucial because the technique for applying stimulation to acupuncture points surrounding K1 and FHA is to narrow the scope of protection being sought.

Also to note that in Stevenson ('087) and in Unsworth ('080), neither have mentioned acupuncture points. Stimulation device disclosed by Stevenson ('087) was general in nature and it is not clear nor obvious to anyone skilled in the field what effect his disclosed device may have in any disease treatment.

In Unsworth ('080), it stated in the abstract: "A single channel neuromuscular electrical stimulation (NMES)...." No acupuncture points stimulation was even mentioned. In paragraph [0026] of our published referenced application, there is disclosure that the claimed method "combination effects of remote peripheral nerve and muscular stimulation..." was not anticipated by Stevenson ('087) nor by Unsworth ('080) nor by other cited references, nor is it obvious or apparent to ones skilled in the art.

It is well known in the art that the Chinese have had acupuncture for thousands of years and the effect of ancient Chinese acupuncture works quite successfully. It has also been proved that acupuncture is able to replace morphine to temporarily stop the nerves from transmitting signals of different kinds. Therefore, there is little argument made to the success of acupuncture.

Again, using electricity to have treatment effects has also been available on the market for many years. As a result, the Applicant does not intend to argue that the delivery of electricity to acupuncture points in the present application is novel and distinguishable over the prior art. But what makes the present application novel and distinguishable over the prior art is that the delivery of electrical stimulation is provided to acupuncture points surrounding K1 and FHA acupuncture points. This limits the scope of protection being sought and distinguishes the present application over the cited prior art in that electrical stimulation to the acupuncture points surrounding K1 and FHA acupuncture points has neither been known in the art nor has been available on the market.

Saying the cited '087 patent discloses the content of the present application and excluding the focus of applying electrical stimulation to acupuncture points surrounding K1 and FHA acupuncture points is somewhat like saying that the curing temperature during a curing process ranging from 50 to 90 degrees is the same as that of 55 to 60 degrees. It is well known in the art that narrowing down the application scope of an art to best deliver the outcome is novel (and may be non-obvious) over the prior art. The admissible fact that there is no disclosure of applying electrical stimulation to acupuncture points surrounding K1 and FHA acupuncture points in the '087 patent gives rise to the novelty of the present application. From the final result of moderating lower and upper back pain, the Applicant of the present application believes that neither the method nor the device placing around the acupuncture points K1 and

FHA were anticipated by Unsworth ('080). The clause in Claim 1 "...moderating lower and upper back pain" also further narrows the scope of the claims.

As such, the Applicant requests reconsideration of the referenced application and favorable action be issued.

The following websites discuss on what acupuncture points needles are usually used to treat back pain. No prior teaching of the Chinese Medicine (TCM) even disclose simultaneous stimulating K1 and FHA acupuncture points.

<http://www.acupuncturetoday.com/archives2002/mar/03lowbackpain.htm>

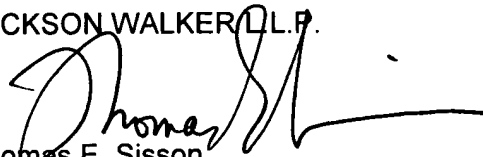
This link shows how doctors treat back pain with acupuncture and electro-acupuncture. None uses K2 and FHA acupuncture points.

<http://www.yinyanghouse.com/chinesetheory/etiology-lowbackpai.htm1#acutx>

If one clicks on an acupuncture point and then clicks on "graphic" on upper left, one can find where these suggested acupuncture points used to treat back pain are. None showed any acupuncture points on the foot.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Thomas E. Sisson", written over the printed name.

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